



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/331,959	09/28/1999	RAYMOND DUBOUIS	022701-831	2312

21839 7590 07/27/2005

BUCHANAN INGERSOLL PC
(INCLUDING BURNS, DOANE, SWECKER & MATHIS)
POST OFFICE BOX 1404
ALEXANDRIA, VA 22313-1404

EXAMINER

MOORE, MARGARET G

ART UNIT	PAPER NUMBER
----------	--------------

1712

DATE MAILED: 07/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/331,959

Applicant(s)

DUBOUIS, RAYMOND

Examiner

Margaret G. Moore

Art Unit

1712

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 May 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 to 35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 to 35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau. (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Art Unit: 1712

1. Claim 27 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicants show three very specific examples which fall within this claimed range for extinction of time. Applicants do not, however, adequately describe a composition within the breadth of claim 1 that meets this requirement. Note for instance that each of the examples that meet this requirement have mixture A. There is nothing in the specification that supports compositions containing mixture B or C and meeting this requirement. The breadth of this claim simply is not supported by the specification and this appears to be new matter.

2. Claim 27 is rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for three specific compositions containing mixture A that fall within this extinction of time range, does not reasonably provide enablement for all or even any other compositions meeting this limitation. The specification does not enable any person skilled in the art to which it pertains or with which it is most nearly connected to make the invention commensurate in scope with these claims. Note for instance that there is nothing in the specification that enables a composition containing mixture B or C and meeting this claimed requirement.

3. Claims 28 to 35 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The phrase "an effective amount" as found in these claims is indefinite since it is unclear what effect is associated with d) and f) and thus it is unclear what constitutes an effective amount.

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Art Unit: 1712

5. Claims 1 to 21, 26 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Takita et al.

This rejection relies on the rationale of record and as such this will not be repeated. Applicants' traversal is insufficient to overcome this rejection.

Applicants first submit that the presence of the azo group *could* change the basic and novel characteristics of the claimed composition. Applicants' attention is drawn to MPEP 2111.03, transitional phrases. This notes that, for the purposes of searching for and applying prior art, absent a clear indication in the specification or claims of what the basic and novel characteristics actually are, "consisting essentially of" will be construed as equivalent to "comprising." In addition, if an applicant contends that additional steps or materials in the prior art are excluded by the recitation of "consisting essentially of," applicant has the burden of showing that the introduction of additional steps or components would materially change the characteristics of applicant's invention. An allegation that the azo group *could* change is clearly not sufficient.

Next applicants argue that Takita does not suggest an "effective amount" of mixture A, B or C. Instant claim 1 initially references an "effective amount" but that amount is further defined by the amounts found at the end of the claim; platinum is present in an amount of 1 to 250 ppm and cerium oxide is present in an amount of .5 to 30 parts by weight. The amounts of platinum and cerium oxide in the composition of Takita falls within these ranges and thus the term "effective amount" is inherently met. See for instance column 2, lines 29 and 38, as well as the amounts found in the working examples.

Finally, applicants' argument that Takita does not suggest any one of the mixture A, B or C is not understood. Takita teach a mixture of cerium oxide and a platinum catalyst. Applicants' response appears to emphasize the term "consists of" in Mixture B but mixture B is a part of a composition that, for prior art purposes at this time, is read to "comprise" any other ingredients.

For these reasons applicants' remarks fail to establish any unobviousness for the instant claims. This rejection is maintained.

Art Unit: 1712

For claim 27, note that this is a flame resistance test and the composition in Takita et al. is nonflammable. While these results are not shown, it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art (i.e. does not require undue experimentation). Similarly, it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art.

6. Claims 1 to 25 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP '644 in view of Matsushita.

This rejection relies on the rationale of record. Applicants' remarks fail to lend any unobviousness to the instant claims. In fact, applicants' remarks filed 5/9/05 appear to be on the same lines as previous arguments already addressed by the Examiner. Applicants arguments are directed towards the working examples and the properties of flame resistance, arc tracking and arc erosion resistance. Please note the first and second full paragraphs in the Examiner's Answer as they address these concerns. Again remember that a prima facie case of obviousness (for a composition) does not require the solution of the same problem or recognition of the same advantages as the applicants invention.

The Examiner relies on the rationale noted supra for the rejection of claim 27.

7. Claims 28, 29, 31 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cavezzan in view of JP '644.

Cavezzan teaches a silicone composition. Particular attention is drawn to the composition in Example 6. This contains each of the claimed components a) – e).

JP '644 teaches that the addition of FeO and Fe₂O₃ to silicone compositions renders them self extinguishing and having improved flame retardancy.

Thus one having ordinary skill in the art would have been motivated by the teachings in JP '644 to add FeO and Fe₂O₃ to the composition of Cavezzan in an effort to improve the flame resistance thereof. It is prima facie obvious to add a known ingredient to a known composition for its known function. As noted previously, a prima

Art Unit: 1712

facie case of obviousness (for a composition) does not require the solution of the same problem or recognition of the same advantages as the applicants invention.

See column 6, line 11, which teaches the addition of quartz.

8. Claims 33 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over McDermott et al. in view of JP '644.

McDermott et al. teach silicone rubber compositions. The compositions include a resin meeting a). See for instance column 3, lines 35 to 40 and column 5, lines 45 to 55. Lines 51, 52 and 53 show resins that specifically meet a) (note that resin a) in claim 33 is open to the inclusion of T units). Column 9, line 40, teaches, as a preferred hydrogen containing organopolysiloxane for crosslinking, a hydrogen terminated polydimethyl-hydrogenmethyl siloxane. This meets c) as claimed. Silane fillers are taught on column 10, lines 37 to 40 and a platinum catalyst is taught on the top of column 10. The composition contains an inhibitor (column 11, line 58 and column 12, line 31) and the working examples use the same inhibitor as claimed component e).

From the teachings in McDermott et al., one having ordinary skill in the art would have found a composition containing claimed components a) through e) to have been obvious.

JP '644 teaches that the addition of FeO and Fe₂O₃ to silicone compositions renders them self extinguishing and having improved flame retardancy.

Thus one having ordinary skill in the art would have been motivated by the teachings in JP '644 to add FeO and Fe₂O₃ to the composition of McDermott in an effort to improve the flame resistance thereof. It is prima facie obvious to add a known ingredient to a known composition for its known function. As noted previously, a prima facie case of obviousness (for a composition) does not require the solution of the same problem or recognition of the same advantages as the applicants invention.

9. Claims 30 and 34 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims. The prior art fails to

Art Unit: 1712

adequately suggest a composition having the particular amounts of each component as required by these claims.

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Margaret G. Moore whose telephone number is 571-272-1090. The examiner can normally be reached on Monday to Wednesday and Friday, 10am to 4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on (571) 272-1302. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 1712

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Margaret G. Moore
Primary Examiner
Art Unit 1712

mgm
7/25/05